



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application Of

Matthew H. Parker, *et al.*

Serial No.: 09/215,593

Filed: December 17, 1998

For: Electronic Document Proofing
System

Examiner: Rachna Singh

Group Art Unit: 2176

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Technology Center 2100

Appeal Brief Under 37 C.F.R. §1.192

Commissioner for Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

Having filed herewith a Notice of Appeal from the final rejection of claims 1-17 and 19-22, all of the claims currently pending, the final rejection being mailed on February 13, 2003, Appellant submits its Appeal Brief for the above-captioned application pursuant to 37 C.F.R. §1.192 in triplicate as follows.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents and Trademarks; Washington, DC 20231.

February 28, 2003


Linda A. Ferranti

Real Party in Interest

The real party in interest is Netformation, Inc., residing at 106 Montague Street; Brooklyn, NY 11201.

Related Appeals and Interferences

There are no related appeals or interferences.

Status Of Claims

Claims 1-17 and 19-22 are currently pending, stand rejected and are the subject of the instant Appeal. A copy of each of these claims is attached hereto as Exhibit A. It should be noted that the Examiner has been treating Claim 18 as having still been pending. However, Claim 18 was cancelled in an Amendment filed on May 30, 2002.

Status Of Amendments

Subsequent to the Final Rejection being mailed on February 13, 2003, Appellant has not filed any Amendments.

Summary Of Invention

As described in the specification, Appellant discloses and claims a system 50 for proofing electronic documents 54 delivered over a network 57. The system 50 comprises a plurality of electronic documents 54 in portable document file

format, a computer 60 connectable to the network 57 for receiving the plurality of portable format documents 54 together with at least one associated proofer identifier 62, a program executing on the computer 60 for assigning a version number to each of the plurality of received portable format documents 54, and a database 64 accessible by the computer 60 for storing the documents and associated version numbers. The computer 60 receives requests, from proofers 52 presenting the proofer identifier 62, to review a portable format electronic document 54, and the program retrieves and formats the requested document 54 for display.

In some cases the request received by the computer 60 is for multiple document versions 54, in which case the program formats multiple versions of a document 54 for simultaneous display. The computer 60 also receives comments 70 submitted by proofers 52, in which case the program stores the comments 70 together with the corresponding document version 54. When a document 54 is requested for display the history of comments 70 received for the document 54 is preferably also simultaneously displayed. The computer 60 also receives and interprets commands 72 from authorized users. One such command 72 is to change the current version of a document 54 which is displayed by default to another version.

References Cited And Applied

U.S. Patent No. 5,790,790 to Smith et al.

U.S. Patent No. 6,088,702 to Plantz et al.

U.S. Patent No. 6,301,592 to Aoyama et al.

U.S. Patent No. 5,438,661 to Ogawa.

Adobe Acrobat Review, <http://www.desktoppublishing.com/reviews/acrobat-1.html>, Adobe Acrobat 3.0, 1993.

Grounds Of Rejection

Claims 1-17 and 19-22 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,088,702 to Plantz et al. ("the '702 patent") in view of U.S. Patent No. 5,790,790 to Smith et al. ("the '790 patent"), further in view of U.S. Patent No. 6,301,592 to Aoyama et al. ("the '592 patent"), further in view of U.S. Patent No. 5,438,661 to Ogawa et al. ("the '661 patent"), and further in view of Adobe Acrobat Review, Adobe Acrobat 3.0, 1993 ("Adobe Acrobat 3.0").

Issues Presented For Review

(1) Whether five prior art references may properly be combined when such combination is taught away from by at least some of the references, and when the teachings of some of the references are repugnant to the teachings of others of the references.

(2) Where even if properly combined, the Examiner may simply pick and choose separate elements from five separate references and combine such

separate elements to render obvious the claims of the present invention despite the fact that the only motivation to do so would be to use the present invention as a "roadmap" or a "recipe" to so combine the elements.

Grouping of Claims

The claims do not stand or fall together. The invention is claimed from several perspectives, each defining the invention in materially different terms.

Each of the independent claims defines the invention from a unique perspective and are materially different in scope. Each independent claim requires a combination of material elements which differs from the combination of material elements required by each of the other independent claims. Each of the dependent claims adds specific additional elements to the novel combination of the independent claims. As such, all claims must be considered because it is improper to fail to consider any limitation in the claims. In re Geerdes, 491 F.2d 1260, 1262, 180 U.S.P.Q. 789, the 791 (CCPA 1974) ("every limitation in the claim must be given effect rather than considering one in isolation from the others").

Argument

All the claims of the present application require, among other elements, documents in portable document file ("PDF") format, a proofer identifier, and retrieving and formatting documents for simultaneous display. In addition,

Claims 1, 17 and 22 further require a system that assigns various version numbers to a document.

The cited prior art does not anticipate or render obvious the claims of the present invention. The '790 patent for instance, relates to a system for delivery of portable documents to a server. Unlike the present invention, the '790 patent fails to disclose, teach or suggest the use of a proofer identifier, version numbers or retrieving and formatting for simultaneous display various versions of the document as required by all the claims. Likewise, the '702 patent fails to disclose, teach or suggest providing portable document file formats, assigning version numbers, or retrieving and formatting for simultaneous display various versions of the document as required by all the claims. Therefore, neither the '790 patent nor the '702 patent anticipate or render obvious any claim of the present invention.

The '592 patent also does not anticipate or render obvious the claims of the present invention. For instance, the '592 patent fails to disclose, teach or suggest providing portable document file formats, a proofer identifier, or retrieving and formatting for simultaneous display various versions of the document as required by all the claims. The '592 patent is not directed toward a group publishing system, but rather is generally directed to a system for displaying various version information of any type of file and/or program in a hierarchical display. (Col. 1, lines 13-15; Col. 4, lines 35-42) Therefore, the '592 patent does not anticipate or render obvious any claim of the present invention.

The '661 patent cited by the Examiner relating to simultaneous display of various versions of a document also does not anticipate or render obvious any claim of the present invention. For example, the '661 patent does not disclose, teach or suggest portable document file formats, a proofer identifier, or receiving a request from a proofer to a program for retrieving and formatting for simultaneous display various versions of the document as required by all the claims. Further, the '661 patent is not directed to a group publishing system but generally to display of data files. (Col. 2, lines 5-6 and 31-32) Therefore, the '661 patent does not anticipate or render obvious any claim of the present invention.

Finally, Adobe Acrobat 3.0 does not anticipate or render obvious the claims of the present invention. For instance, Adobe Acrobat 3.0 fails to disclose, teach or suggest the use of a proofer identifier, version numbers or retrieving and formatting for simultaneous display various versions of the document as required by all the claims. Rather, Adobe Acrobat 3.0 is related to PDF formats. Therefore, Adobe Acrobat 3.0 does not anticipate or render obvious any claim of the present invention.

Moreover, Appellant respectfully submits that the above-listed references are not properly combined in order to formulate an obviousness rejection. There is no suggestion to combine the cited prior art and in fact, the references themselves teach away from combination.

For instance, Appellant respectfully disagrees with the Examiner's suggestion that the '790 patent and the '702 patent are properly combined because both relate to the field of document processing. The '790 patent relates to a delivery system and has nothing to do with a collaborative group publishing system where documents may be edited and various versions kept for simultaneous display. Appellant further respectfully disagrees with the Examiner's suggestion that it is proper to combine the '592 patent with the '661 patent because they are both related to editing documents and providing various versions for display. As noted, the '661 patent is directed toward display of data files whereas the '592 patent is directed toward keeping track of both data files and programs.

The Examiner has also suggested that it is proper to combine the '702 patent with both the '790 patent and Adobe Acrobat 3.0. There is not suggestion in any of these references to combine them. In fact, the various patents themselves teach against the combination suggested by the Examiner. For instance, one of the stated objects of the '702 patent is "the provision of: An Internet-based word-processing and editing GPS for documents ... that is HTML-based and allows audio and video to be embedded in the text itself." (Col. 5, lines 24-26 & 28-30) Another stated object of the '702 patent is "the provision of: ... An HTML-based word-processing system that allows instant downloading of text to existing pre-press formats, such as Quark or Pagemaker, and uploading of pictures, graphics, video or audio data in any format." (Col. 5, lines 24 & 36-39) The '702 patent further

states, "A further object of the present invention is to provide a method to allow essentially simultaneous viewing of an entire in-process document, which can be downloaded for publication in a variety of formats, including but not limited to CD-ROM, hard-copy book, or on-line HTML format." (Col. 5, lines 19-23) These stated objectives of the '702 patent cannot be achieved when combined with either or both the '790 patent and/or Adobe Acrobat 3.0 as the Examiner has suggests. For instance, combining the Exchange feature of Adobe Acrobat 3.0 and the '790 patent (which utilizes a portable format) with the '702 patent would not allow audio and video to be embedded in the text itself, and all the claims of the present invention require PDF format, not a variety of formats. In addition, one of the objects of the '702 patent states that "[m]ultiple user can simultaneously work on the same project." (Col. 5, line 4) However, because all of the claims of the present invention require the use of PDF format, which is an image file, users do not "simultaneously work on the same project" and "simultaneous viewing of an entire in-process document" does not happen. Therefore, not only is there no motivation to combine the '702 patent with Adobe Acrobat 3.0 and the '790 patent, due to the stated objects of the invention in the '702 patent, these references specifically teach away from the suggested combination. Therefore, combination of the '702 patent with either or both the Adobe Acrobat 3.0 and/or the '790 patent is not proper because the stated objects of the invention for these references are incompatible and mutually exclusive.

Appellant respectfully submits that there is no motivation in any of the cited references to combine them as the Examiner has suggested and in fact, the references themselves teach away from the suggested combination.

Even if the '702 patent were combined with the Adobe Acrobat 3.0 or the '790 patent despite the lack of motivation to do so and the fact that the combination is actually taught against by the references themselves, an individual would not arrive at a system which renders obvious the claims of the present application. For instance, one is taught by the objects stated in the '702 patent that it is desirable to embed audio and video in the text itself. Thus, an individual would be taught to create a group publishing system for displaying, modifying and embedding directly into a file or document; video and/or audio data in many differing and varied formats for presentation. (Col. 5, lines 38-42 & 50-55) This, however, would be a vastly different system from the claimed invention, of which all the claims require utilization of a PDF format.

Alternatively, combination of the '592 patent with the '790 patent or Adobe Acrobat 3.0 would likewise result in a system in which various versions of programs are displayed and maintained in PDF format, which would render programs maintained in that format inoperable. Because there are a number of different systems that may be arrived at if the above-cited references were combined as the Examiner is suggesting, many if not all of which would not render obvious the present invention as claimed, Appellant respectfully submits that the Examiner's rejection is improper. Moreover, even if the present

invention as claimed could somehow be pieced together from various element of the five cited references, it would be necessary to utilize the claimed present invention as a road map in order to do so, particularly in light of the fact that the references themselves teach away from such a combination.

Conclusion

Appellant has made a significant advance over the prior art by providing a system which simultaneously displays multiple versions of portable format document over a computer network, which enables a collaborative reviewer to change a current version of a portable format document, which simultaneously displays a history of comments from collaborative reviewers together with each version of a portable format document, and which is capable of providing this functionality to multiple reviewers of multiple versions of multiple documents. Accordingly, reconsideration and allowance of all pending claims is believed in order, and such action is earnestly solicited.

Respectfully submitted,

February 27, 2003



Wesley W. Whitmyer, Jr., Registration No. 33,558
Todd M. Oberdick, Reg. No. 44,268
ST. ONGE STEWARD JOHNSTON & REENS
986 Bedford Street
Stamford, Connecticut 06905
(203) 324-6155

Attorneys for Appellant

EXHIBIT A - Pending Claims

1. A system for proofing electronic documents delivered over a network, comprising:
 - a plurality of electronic documents in portable document file format;
 - a computer connectable to the network for receiving the plurality of portable format documents together with at least one associated proofer identifier;
 - a program executing on said computer for assigning a version number to each of the plurality of received portable format documents; and
 - a database accessible by said computer for storing the documents and associated version numbers;
 - said computer for receiving a request, from a proofer presenting the proofer identifier, to review multiple versions of a portable format electronic document;
 - said program for retrieving and formatting the requested multiple document versions for simultaneous display to permit visual comparison.
2. The system of claim 1 in which the network is the internet.

3. The system of claim 2 in which said program sends an email each time a new document version is received, notifying the proofer that it is available for review.

4. The system of claim 2 in which said computer includes a webserver program for publishing document versions to proofers.

5. The system of claim 4 in which said computer executes scripts permitting the proofer to request information from said database through the webserver program.

6. The system of claim 4 in which said computer executes scripts which interpret commands entered by the proofer.

7. The system of claim 1 in which said computer receives comments from proofers concerning the document versions, and in which said program stores the comments in said database together with the corresponding document version.

8. The system of claim 7 in which said computer formats a history of received comments for display together with a document version.

9. The system of claim 1 wherein said program retrieves records corresponding to each of the requested document versions and assembles URLs pointing toward the documents from data in the records.

10. A system for proofing electronic documents delivered over a network, comprising:

- a database of portable format electronic documents stored together with at least one proofer identifier;

- a computer connectable to the network for receiving a plurality of comments, each concerning a particular one of the portable format documents;
- and

- a program executing on said computer for associating and storing the received plurality of comments together with the particular portable format electronic documents;

- said computer for receiving a request, from a proofer presenting the proofer identifier, to review a particular portable format electronic document;

- said program for retrieving and formatting the requested document together with the associated plurality of comments for simultaneous display to permit review.

11. The system of claim 10 in which at least some of the plurality of comments are received by said computer together with a proofer identifier.

12. The system of claim 10 in which at least some of the plurality of comments are received by said computer together with a creator identifier.

13. The system of claim 10 in which the network is the internet.

14. The system of claim 13 in which said program sends an email each time a new comment version is received, notifying the proofer that it is available for review.

15. The system of claim 10 in which said program retrieves and formats multiple versions of a requested document together with the associated plurality of comments for simultaneous display to permit visual comparison and review.

16. The system of claim 10 wherein said program retrieves a record corresponding to the requested document and assembles a URL pointing toward the document from data in the record.

17. A system for proofing electronic documents delivered over a network, comprising:

a plurality of electronic documents in portable document file format:

a computer connectable to the network for receiving the plurality of

portable format documents together with at least one associated proofer identifier;

a program executing on said computer for assigning a version number to each of the plurality of received portable format documents; and

a database accessible by said computer for storing the documents and version numbers;

said computer for receiving a request, from a proofer presenting the proofer identifier, to review a portable format electronic document;

said program for retrieving and formatting a current version of the requested document for display;

said computer for receiving a version command from a proofer presenting the proofer identifier;

said program for interpreting the version command to replace the current version of the document with a different version of the portable format electronic document;

wherein said program retrieves and formats multiple versions of the requested document for simultaneous display.

19. The system of claim 17 in which said computer receives comments from proofers concerning the document versions, and in which said program stores

the comments in said database together with the corresponding document version.

20. The system of claim 19 in which said computer formats a history of received comments for display together with a document version.

21. The system of claim 17 in which the network is the internet and in which said computer includes a web server program.

22. A system for proofing electronic documents delivered over a network, comprising:

a plurality of electronic documents in portable document file format;

a computer connectable to the network for receiving the plurality of portable format documents together with at least one associated proofer identifier;

a program executing on said computer for assigning a version number to each of the plurality of received portable format documents; and

a database accessible by said computer for storing the documents and associated version numbers;

said computer for receiving a plurality of comments, each concerning a particular one of the portable format document versions;

said computer for receiving a request, from a proofer presenting the proofer identifier, to review multiple versions of a portable format electronic document;

said program for retrieving and formatting the requested multiple document versions for simultaneous display together with corresponding comments to permit visual comparison;

said computer for receiving a version command from a proofer presenting the proofer identifier;

said program for interpreting the version command to replace the current version of the document with a different version of the portable format electronic document.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	Matthew H. Parker, <i>et al.</i>
Serial No. 09/215,593	Filing Date: December 17, 1998
Title of Application:	Electronic Document Proofing System
Confirmation No. 7204	Group Art Unit: 2176
Examiner	Rachna Singh

Commissioner for Patents
and Trademarks
Washington, DC 20231

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**Notice of Appeal to the Board of Patent Appeals and
Interferences, Transmittal Of Appeal Brief and Request For Oral Hearing**

Dear Sir:

Applicants hereby appeal to the Board from the Office Action, mailed February 13, 2003, finally rejecting claims 1-17 and 19-22, all pending claims in the application. It should be noted that the Examiner has been treating Claim 18 as having still been pending. However, Claim 18 was cancelled in an Amendment filed on May 30, 2002.

1. **Appeal Brief.** Transmitted herewith, in triplicate, is the Appeal Brief with respect to the Notice of Appeal filed herewith.
2. **Fee for Filing Notice of Appeal.** Pursuant to 37 C.F.R. 1.17(b), the fee for filing this Notice of Appeal is \$160.00. Applicants claim small entity status.
3. **Time To Reply.** The final rejection is dated February 13, 2003. The period for response granted therein is three months from the date thereof. Thus, this Notice is timely filed on or before May 13, 2003.

03/07/2003 MAHME1 00000038 09215593

03 FC:2403

140.00 OP

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February 28, 2003

Linda A. Ferranti

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Serial No. 09/215,593

Applicants: Matthew H. Parker, *et al.*

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4. **Fee for Filing Appeal Brief.** Pursuant to 37 C.F.R. 1.17(c), the fee for filing the Appeal Brief is \$160.00. Applicants claim small entity status.
5. **Request for Oral Hearing.** Applicant hereby requests an Oral Hearing.
6. **Fee for Requesting Oral Hearing.** Pursuant to 37 C.F.R. 1.17(d), the fee for requesting an Oral Hearing is \$140.00. Applicants claim small entity status.

7. **Total Fee Due.** The total fee due is:

Notice of Appeal fee	\$160.00
Appeal Brief fee	\$160.00
Request for Oral Hearing	<u>\$140.00</u>
Total	\$460.00

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8. **Fee Payment.** Attached is a check in the amount of \$460.00. This is also a petition and a request to charge to Account No. 19-4516 for any additional extension and/or fee as may be required or credit for any excess fee paid.

Respectfully submitted,

February 27, 2003

Todd M. Oberdick

Wesley W. Whitmyer, Jr., Registration No. 33,558
Todd M. Oberdick, Reg. No. 44,268
Attorneys for Applicants
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155